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10/604,276

07/08/2003

Frank Olschewski

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29127 7590 10/23/2008  
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EXAMINER

KIM, CHONG R

ART UNIT

PAPER NUMBER

2624

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DELIVERY MODE

10/23/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/604,276 | <b>Applicant(s)</b><br>OLSCHEWSKI, FRANK |  |
|                              | <b>Examiner</b><br>CHARLES KIM       | <b>Art Unit</b><br>2624                  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's Appeal Brief filed on July 22, 2008 has been entered and made of record.
2. Applicant's arguments in the brief have been fully considered and are persuasive. In particular, Applicant's argument that Elings does not disclose a non-scanning actuator—an actuating device that does not actuate any scanning motion—is persuasive. (Appeal Brief, p. 5). Therefore, the rejections and the finality of the previous Office action have been withdrawn. However, upon further consideration, a new ground(s) of rejection is made, the details of which are provided below.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 6 and 8 rejected under 35 U.S.C. 102(e) as being anticipated by Yamada et al., U.S. Patent Application Publication No. 2003/0132401 (hereinafter Yamada).

Referring to claim 6, Yamada discloses an arrangement for monitoring and controlling a microscope [fig. 4], comprising:

a detector unit (CCD) for acquiring at least one image [par. 77];

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at least one input port for a control variable [pars. 77-82. Note that LED light source has an input for a control variable.];

a computer system associated with the microscope, wherein the information content of the at least one image can be ascertained using the detector unit and the computer system; the computer system analyzes the information content using a specified target information content and a specified variation of the information content as the tolerance dimension, and determines a control variable therefrom; from the analysis of the information content, using a predetermined target value for influencing the information content [pars. 67 and 77-82. Note that a determination is made as to whether the measured values of the information content output from the detector unit (light adjustment data) are within a tolerance. Also, note that a control variable for a light source is generated based on the light adjustment data.]

at least one non-scanning actuator associated with the microscope, wherein the actuator converts the control variable allocated to the actuator into a change in the information content of the image within a tolerance dimension [pars. 77-87. Note that either the light intensity or the gain can be adjusted according to the light adjustment data, in order to maintain a tolerance dimension.].

Referring to claim 8, Yamada further discloses that several non-scanning actuators are associated with the microscope, each of which receives a different control variable [pars. 77-87. Note that the light intensity and gain can be adjusted, each of which having different control variables.].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 5, 7, 11, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Yamada and Elings et al., U.S. Patent No. 5,077,473 (hereinafter Elings).

Referring to claim 1, Yamada discloses a method for monitoring and controlling a microscope, comprising the following steps:

a) ascertaining the information content of at least one image [par. 77. Note that the output signal from the CCD sensor is detected.];

b) analyzing the information content using a specified target information content and a specified variation of the information content as the tolerance dimension [par. 77. Note that a determination is made as to whether the measured values are within a tolerance.];

c) determining a control variable from the analysis of the information content, using a predetermined target value for influencing the information content [pars. 77-82. Note that a control variable for a light source is generated based on the light adjustment data.]; and

d) transferring the control variable to at least one non-scanning actuator of the microscope [pars. 77-82. Note that the control variable is transferred to a light source actuator for adjusting the light intensity, or the gain (see par. 87).].

Yamada does not explicitly disclose the step of outputting a warning signal in the event of variations of the information content beyond the tolerance dimension. However, this feature

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was exceedingly well known in the art. For example, Elings discloses outputting a warning signal in the event of variations of image information content beyond a tolerance dimension [col. 10, ll. 61-65].

Yamada and Elings are combinable because they are both concerned with adjusting microscope control parameters. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Yamada to include the step of outputting a warning signal in the event variations of the information content go beyond the tolerance dimension, as taught by Elings. Yamada provides for adjusting microscope control parameters in order to maintain image content data within a tolerance dimension. Elings provides the added benefit of informing the user by a warning signal when the variations of the image content data go beyond the tolerance dimension. Accordingly, one of ordinary skill could have easily included Elings's warning signal in Yamada's method to produce the predictable result of informing the user in the event the variations of the image content data go beyond a tolerance dimension. Therefore, it would have been obvious to combine Yamada with Elings to obtain the invention as specified in claim 1.

Referring to claim 2, Yamada further discloses that depending on the result of the analysis of the information content, several different control variables and non-scanning actuators of the microscope are determined and activated [pars. 77-87].

Referring to claim 5, Yamada further discloses that the microscope is embodied as a scanning microscope [fig. 4].

Referring to claim 7, see the rejection of at least claim 1 above.

Referring to claim 11, see the rejection of at least claim 5 above.

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Referring to claim 12, see the rejection of at least claim 1 above.

5. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Yamada, Elings, and Tsuneta et al., U.S. Patent No. 6,570,156 (hereinafter Tsuneta).

Referring to claims 3 and 4, see the discussion of claims 9 and 10 below.

6. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Yamada and Tsuneta.

Referring to claims 9 and 10, Yamada does not explicitly disclose that the automatic monitoring of the microscope is initiated by a user by means of a switch that is embodied as a click button on a display associated with the computer system. However, this feature was exceedingly well known in the art. For example, Tsuneta discloses initiating the monitoring of a microscope by a switch embodied as a click button on a display associated with a computer system [fig. 2. Note that the GUI allows a user to control and monitor a microscope .].

Yamada and Tsuneta are combinable because they are both concerned with microscope control systems. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Yamada to include the user initiated switch of Tsuneta. Tsuneta's switch would have provided the added benefit of allowing the user to control and monitor the microscope using an easy to use interface. Therefore, it would have been obvious to combine Yamada with Tsuneta to obtain the invention as specified in claims 9 and 10.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kim whose telephone number is 571-272-7421. The examiner can normally be reached on Mon thru Thurs 8:30am to 6pm and alternating Fri 9:30am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on 571-272-7453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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October 21, 2008